

160, 161, 165-171, 176, and 183-187 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky.

Claims 1, 19, 28, 46, 55, 73, 82, 100, 109-111, 113, 115-117, and 119 are independent.

II. Rejection Under 35 U.S.C. § 102(b)

The Examiner has maintained his rejection of independent claims 1, 19, 55, 73, 100, and 109-111 under 35 U.S.C. 102(b) as being anticipated by Bocinsky. However, Applicant submits that Bocinsky fails to disclose all aspects of the claimed invention.

For example, Bocinsky fails to disclose a file containing a digital representation of money. The Examiner maintains from the previous Office Action his belief that Bocinsky discloses this aspect of the claimed invention, arguing “this limitation is disclosed by Bocinsky in col. 11, lines 3-34, col 12, lines 4-34, fig 2, elements 30 and 36 ...”.

However, nowhere in these sections is a file containing a digital representation of money disclosed. Instead, the cited column 11, lines 3-34 simply note:

“Secure transaction processor 30 includes a microprocessor or other CPU apparatus 31 with associated external random access memory (RAM) 32 and read only memory (ROM) 35 connected thereto. Additionally, magnetic memory is provided by a disk drive shown as 36 for storing customer registration records as described in greater detail hereinbelow. Of course, other storage media may be employed in embodiments of the present invention but relatively large hard disk drives are currently preferred.

Transaction processor 30 includes a data communications interface 18' that communicates via data link 26' with the network security transaction processor 22 in a manner identical to that of the prior art illustrated in FIG. 1. The preferred embodiment includes speech synthesizing

apparatus. Typically, the data communications interface 18' will be a multiport device that can handle a plurality of transactions at any given time. Two representative input ports are shown as 37 and 38 in FIG. 2.

Port 37 is connected to a DTMF decoder 39 that is, in turn, connected to a subscriber line 40 that forms part of the public switched telephone network (PSTN). In FIG. 2, subscriber line 40 is shown as connected to a typical telephone set 41 having a DTMF keypad 42 by which the user can transmit numeric information to transaction processor 30. As will be apparent to those skilled in the art, the function DTMF decoder 39 may also be implemented by an external DTMF decoder that passes decoded data to secure transaction processor 30 or by apparatus which allows processor 31 to directly decode inbound DTMF signals."

while the cited lines column 12, lines 4-34 note:

"As noted briefly hereinabove, secure transaction processor 30 may be one of a plurality of processors located at various locations, or a central computer operated by the client of the regional network. In this specification, the client of the system is the entity that will be receiving the electronics funds transfer authorized by its customer. Thus, the customer is the party that owns the bank account and the client is the party to whom the customer wishes to transfer funds. Alternately, the secure transaction processor may be embodied by any form of specialized computer that is connected to or forms a part of central office switching equipment by a telephone company. One example of same are service circuit nodes that connect directly to electronic switching equipment for a central office such as those manufactured and sold by American Telephone & Telegraph Company.

Another data link 47 is shown as coming from data communications interface 18 and going to a client order processor. This link is typically an asynchronous serial link or a connection via local area network. Alternately, an asynchronous link may be connected to a modem for transmission of order information to a computer at a remote site. Of course, the computer that constitutes secure transaction processor 30 may also perform the function of a client order processor. A client order processor is contemplated when, for example, the system is being used by

a mail order retail operation. Disk drive 36 holds customer records for registered customers and also maintains information on customer transactions."
(emphasis added)

With regard to the Examiner's reference to elements 30 and 36 of Fig. 2, Applicant draws the Examiner's attention to the emphasized section of column 12, lines 4-34 as quoted above. As the emphasized lines make clear, element 30 is a transaction processor that "may also perform the function of a client order processor" while element 36 is a disk drive that "holds customer records for registered customers and also maintains information on customer transactions"; neither element is disclosed to be or relate to a file containing a digital representation of money.

In light of this, Applicant submits that the cited sections of Bocinsky fail to disclose a file containing a digital representation of money. Furthermore, Applicant has looked beyond the cited sections to the rest of the patent and found no such disclosure. Instead, Applicant finds Bocinsky's disclosure that his system performs conventional electronic funds transfer:

"... the regional network authorization processor ... communicates with the customer's bank to process the transaction in a conventional fashion ..."
(see col. 17 ln. 65-58; Emphasis added).

At col. 2 ln. 15-23, Bocinsky explains how such a conventional transaction operates:

"The host computer at the bank then returns data to the network computer indicating whether or not the transaction is authorized. If same is authorized and it is, for example, a cash withdrawal, the account of the customer will be immediately debited at the host computer operated by that customer's bank. The network computer passes the authorization upstream ... "

(emphasis added)

Applicant believes it is clear that sending a simple authorization to dispense money is not at all like sending a file containing a digital representation of money. Accordingly, Applicant submits that Bocinsky fails to disclose at least the claimed aspect of:

“... a computer file containing a digital representation of money ...”

as stated by independent claim 1, with similar matter being stated by independent claims 19, 55, 73, 100, and 109-111.

As a second example of matter of the claimed invention not disclosed by Bocinsky, Applicant draws the Examiner's attention to the aspect of independent claim 1 that includes:

“... assigning at least one security attribute to a digital representation of money ...”,

the aspect of independent claim 19 that states:

“... receiving a computer file containing a digital representation of money, wherein the file containing a digital representation of money has at least one security attribute which precludes unauthorized access to the file ...”
(emphasis added),

and the related matter of independent claims 28, 46, 55, 73, 82, 100, 109-111, 113, 115-117, and 119.

According to the Examiner, Bocinsky discloses:

“... the steps of requiring a recipient of the file containing a digital representation of money enter password, social security number, the social security number taught by Bocinsky performs the same function as the Applicant's

claimed invention, and the PIN number is considered as a password”

However, Applicant points out that in this section Bocinsky fails to disclose that which the Examiner states and instead discloses that “a service access number” such as “the customer’s social security number” is entered by “a customer that wishes to register with a mail order retail establishment for immediate debit or secure credit card transactions” (see Bocinsky col. 4 ln 1-4 and 38-40; emphasis added). Applicant submits that customer registration for transactions is not at all like, for example, receiving a computer file containing a digital representation of money, wherein the file has at least one security attribute which precludes unauthorized access to the file, nor is it at all like assigning such a security attribute to such a file.

For at least these reasons, Applicant submits that independent claims 1, 19, 55, 73, 100, and 109-111 are in condition for allowance. Moreover, those claims which depend therefrom (claims 2-18, 20-27, 56-72, 74-81, 101-108, 112, 121, 122, 125, 126, 128-130, 140-149, 155-164, 170-174, and 177-182) also thought to be in condition for allowance for at least the same reasons.

III. Rejection Under 35 U.S.C. § 103(a)

Independent claims 28, 46, 82, 113, 115-117, and 119 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky.

In order to establish a case of prima facie obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations” (see MPEP, section 2142). For at least the reasons stated above, Bocinsky fails to disclose:

“... a computer file containing a digital representation of money ...”

as stated by independent claim 28, with similar matter being stated by independent claims 46, 82, 113, 115-117, and 119.

Furthermore, for at least the reasons stated above, Bocinsky fails to disclose:

“... assigning at least one security attribute to the file containing a digital representation of money ...”

as stated by independent claim 28,

“... receiving an electronic mail message with an attached digital representation of money, wherein the file containing the digital representation of money has at least one security attribute which precludes unauthorized access to the file ...”
(emphasis added)

as stated by independent claim 46, and the related matter of independent claims 82, 113, 115-117, and 119.

As Bocinsky fails to teach or suggest these claim limitations, Applicant submits that the Examiner fails to establish a case of prima facie obviousness against independent claims 28, 46, 82, 113, 115-117, and 119.

Additionally, Applicant submits that the Examiner fails to meet the criterion for establishing a prima facie case of obviousness wherein:

“... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings ...”

(see MPEP, section 2142).

Independent claim 28 states:

“... attaching the file containing a digital representation of money to an electronic mail message ...”

Similar matter is disclosed by independent claims 46, 82, 113, 115-117, and 119.

The Examiner concedes that Bocinsky fails to disclose this aspect of the claimed invention, and takes Official Notice in an attempt to remedy this deficiency:

“... [the] Examiner hereby takes Official Notice that electronic mail is notoriously well-known in the art.”

The Examiner then suggests that it would be obvious to combine the teaching of Bocinsky with the matter of his Official Notice because “electronic mail is an object of the internet”.

Applicant wishes to reiterate that Bocinsky fails to disclose a file containing a digital representation of money. However Applicant submits that even if Bocinsky did make such a disclosure, the Examiner would fail to identify a prior art teaching to combine that disclosure with the matter of the Official Notice so as to attach a file containing a digital representation of money to an electronic mail message. Applicant submits that the motivation to combine offered by the Examiner fails to meet the requirements for establishing a prima facie case of obviousness and represents little more than the Examiner’s opinion as to the nature of email. Applicant submits that using email, an inherently insecure medium, to securely transmit money is not taught, disclosed, or suggested by the prior art.

Therefore, for at least the additional reason that Bocinsky fails identify a prior art teaching to combine any disclosure of Bocinsky with the matter of the Official Notice, Applicant submits that the Examiner fails to establish a case of prima facie obviousness against independent claims 28, 46, 82, 113, 115-117, and 119.

For at least these reasons, Applicant submits that independent claims 28, 46, 82, 113, 115-117, and 119 are in condition for allowance. Moreover, those claims which depend therefrom (claims 29-45, 47-54, 83-99, 114, 118, 120, 123, 124, 127, 131-139, 150-154, 165-169, 175, 176, and 183-187) are also thought to be in condition for allowance for at least the same reasons.

CONCLUSION

Applicant respectfully submits that this application is in condition for allowance for which action is earnestly solicited.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 3892-4000. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

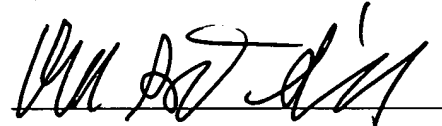
Furthermore, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-noted Deposit Account and Order No.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: December 19, 2001

By:

A handwritten signature in black ink, appearing to read 'Angus R. Gill', is written over a horizontal line.

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